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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/031,690      | 05/31/2002  | Frank Bongardt       | H 4043 PCT/US       | 8266             |

23657 7590 10/02/2006

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| EXAMINER |
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TOOMER, CEPHIA D

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1714

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/031,690 | <b>Applicant(s)</b><br>BONGARDT ET AL. |  |
|                              | <b>Examiner</b><br>Cephia D. Toomer  | <b>Art Unit</b><br>1714                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 14-27, 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 14, 2006 has been entered.

2. This Office action is in response to the amendment filed July 14, 2006 in which claims 14, 27 and 28 were amended.

Applicant's arguments with respect to the obviousness double patenting rejection are persuasive and the rejection is withdrawn.

3. The 103 rejection is withdrawn in view of the amendment to the claims.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 is rejected because claim 28 is closed to the further components.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14-27 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenzel US 20030093941.

Wenzel teaches a fuel additive composition comprising a) one or more water-soluble alcohols having between 1 and 5 carbon atoms in an anhydrous state or as a 0.5-36 % aqueous solution one or more of b) one or more straight or branched chain alcohols having between 6-18 carbon atoms and c) one or more ethoxylated alcohols having between 12 and 18 carbon atoms where the ethylene oxide add-on is less than 5 moles and d) a source of nitrogen in an anhydrous state or as an aqueous solution (see abstract paragraph 223-229). The fuel may be any fossil fuel such as diesel (see paragraph 243). The composition may or may not contain water (see col. 28, examples and paragraphs 0440 & 0666). Wenzel teaches numerous fuel to additive ratios that encompass the claimed proportions, for example 99:1 to 50:50 (see paragraph 229).

In the examples, Wenzel discloses that the alcohols having 6-18 carbon atoms are present in the composition in an amount from 6-32 parts by volume (see paragraph 375, 377, 379, 381, etc) and the ethoxylated alcohol is present in an amount from 2-32 parts by volume (see paragraph 381, 383, 385). The other additive (a source of nitrogen) is present in the composition in an amount from 0.3-6 parts by volume (see

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paragraph 375, 381, 379). Wenzel teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Wenzel differs from the claims in that he does not specially teach a composition wherein the C<sub>12</sub> – C<sub>24</sub> branched alcohol is present. However, it would have been obvious to one of ordinary skill in the art to have employed such a compound because Wenzel teaches that one or more straight or branched-chain alcohol having 6 – 18 carbon atoms may be employed, and he exemplifies straight chain alcohols having 18 carbon atoms. The combination of these teachings clearly suggests that a branched chain of 18 carbon atoms may be included in the composition.

4. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that Wenzel consistently discloses the use of a short chain alcohol as component (a) in combination with one or more of components (b), (c) or (d) to form the emulsion. Applicant argues that there is no teaching or suggestion to omit the short chain alcohol. Applicant argues that Wenzel discloses straight and branched chain alcohols, but does not exemplify a C<sub>12</sub>-C<sub>24</sub> branched alcohol. Applicant argues that Wenzel contains the branched alcohol and ethoxylated alcohols as optional components.

Applicant's claims are not limited to the recited components. The claims recite a composition comprising.... This language opens the claims to additional components and does not exclude the short chain alcohol of Wenzel. It is well settled that a reference is relied upon for all that it teaches and is not limited to the examples

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contained therein. Wenzel teaches that the one or more straight or branched chain alcohols have between 6 and 18 carbon atoms. This teaching suggests applicant's C<sub>12</sub>-C<sub>24</sub> branched-chain fatty alcohol.

Applicant's argument with respect to Wenzel teaching the branched alcohol and ethoxylated alcohol as optional components is irrelevant in the absence of unexpected results. The skilled artisan having Wenzel before him/her recognizes that the fuel composition may be prepared containing these components.

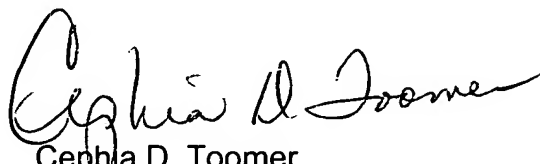
Claim 28 is allowable because the prior art fails to teach or suggest the concentrate consisting of the branched-chain fatty acid and an ethoxylated fatty alcohol having from 8-24 carbon atoms and 1-10 moles of EO.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Cepha D. Toomer  
Primary Examiner  
Art Unit 1714

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